

No. 83-733  
IN THE

**Supreme Court of the United States**

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October Term, 1983

ENVIRONMENTAL DESIGNS, LTD. and THE TRENTHAM  
CORPORATION,

*Petitioners,*

vs.

UNION OIL COMPANY OF CALIFORNIA and THE RALPH M.  
PARSONS COMPANY,

*Respondents.*

ON PETITION FOR A WRIT OF CERTIORARI  
TO THE UNITED STATES COURT OF APPEALS  
FOR THE FEDERAL CIRCUIT.

**BRIEF OF RESPONDENTS IN  
OPPOSITION TO PETITION FOR  
A WRIT OF CERTIORARI.**

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**Rule 28.1: List of Parent Companies,  
Subsidiaries and Affiliates.**

The Respondents in the case are Union Oil Company of California, a corporation, and The Ralph M. Parsons Company, a corporation.

Pursuant to Rule 28.1 of this Court, Respondent Union Oil Company of California is a wholly owned subsidiary of Unocal Corporation, a Delaware corporation whose stock is publicly traded. Union Oil Company of California has stock holdings in Keneb Services, Inc. and Magma Power Company.

Respondent The Ralph M. Parsons Company is a wholly owned subsidiary of The Parsons Corporation, a Delaware corporation whose stock is publicly traded as a unit with RMP International, LTD., organized and existing under the laws of the Cayman Islands. Reliability Inc., a Texas corporation, is a subsidiary of The Parsons Corporation, some stock of which is publicly held. The following are affiliates of The Parsons Corporation: Inmobiliaria Nunoa Limitada, Chile; Latinoamericana de Ingenieria, S.A. de C.V., Mexico; Parmetal Ingenieria y Constucciones Limitada, Chile; Parsons-Eluma Projetos e Consultoria S/C Ltda., Brazil; and Saudi Arabian Parsons Limited, Saudi Arabia. The following are less than wholly owned subsidiaries of The Parsons Corporation: H. F. Bishop & Associates, Inc., a California corporation; Engineering-Science Pacific, Limited, Hong Kong; and ES Environmental Services, Inc., a California corporation.

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**BRIEF OF RESPONDENTS IN  
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**Preamble.**

Contrary to petitioners' assertions in the Conclusion of their petition, the United States Court of Appeals for the Federal Circuit (CAFC) has in this case neither "set aside" nor "reversed" any decisions of this Court or of any other court of appeals. This petition amounts to nothing more than an effort to involve this Court in further review of asserted errors in fact finding. Such a review has already been made by the CAFC and that court unanimously affirmed the judgment of the district court holding U.S. Patent, 3,752,877 ('877 patent) valid and its claims literally and substantively infringed.

The infirmity common to both of the proffered Questions Presented is that the questions could become real issues only if a threshold finding were made as to the existence of the factual postulate that is set forth in each. But such a finding would in each case be contrary to express findings made by the district court supporting its holding that petitioners' process comes within claims of the '877 patent in every substantive respect. (Pet. App. B-32<sup>1</sup>.) Upon review, the CAFC found no error in those findings.

The affirmance by the CAFC involves therefore no conflict with any decision of this Court or with any decision of any other court of appeals. This case involves a dispute between private parties concerning specific disputed factual matters; those were decided at the district court level based upon extensive and often-conflicting evidence. The affirmance by the CAFC involved a careful review of the lower court's findings and proper application of the "clearly erroneous" standard to those findings. The case does not warrant further review.

### **Counter-Statement of the Case.**

The '877 patent covers the invention of a plant gas clean-up process by which the sulfur content of plant gases discharged into the atmosphere is reduced to a level low enough to be environmentally acceptable. The heart of the process is set out in clause (a) of claim 1 which requires simultaneous catalytic hydrogenation and hydrolysis of sulfur compounds. (Finding 65, Pet. App. B-18.)

The district court found that the practice of the invention of the '877 patent was not solely limited to the practice described in the disclosure as "preferred". The invention

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<sup>1</sup>Appendix references herein refer to the Appendix submitted with the petition and follow the abbreviations used in the petition.

could also be performed by following practices that are convenient alternatives and substantively the same. (Finding 66, Pet. App. B-19.)

At the stage of proceedings in the U.S. Patent and Trade-mark Office at which the argument quoted in petitioners' Statement of the Case was made, the rejected claims referred only to hydrogenation of sulfur compounds and did not refer to simultaneous catalytic hydrogenation *and* hydrolysis. Those claims were amended to include "separating condensed water from the hydrogenated gas stream". The claims as so amended were not allowed.

The claims that were later allowed all specifically referred to simultaneous catalytic hydrogenation and hydrolysis of sulfur compounds. The findings of the district court, particularly findings 67-69 (Pet. App. B-19), reflect the review by that court of the entire file history of the '877 patent in its weighing of the issue of the interpretation placed by applicant and the Patent Office examiner upon the patent claims.

The district court concuded (Conclusion 16, Pet. App. B-32) that none of the independent claims in the patent were ever modified to include the phrase "prior to contact (with an aqueous absorption solution)" either expressly or by necessary implication. It further concluded that its determination that claim 1 of the '877 patent covered petitioners' process did "not expand the claims to include any principles originally rejected or their equivalents."

The district court compared the process claimed in the patent with petitioners' accused process in extensive findings based upon the technical evidence that had been adduced at trial. The district court found: "Thus, every clause of claim 1 applies substantively to a corresponding step of the Trencor H<sub>2</sub>S process (petitioners' process). As a whole,

the patented process and the Trencor H<sub>2</sub>S process involve the same principles; they use the same steps; they perform these steps in the same sequential order; and they produce the same result." (Finding 93, Pet. App. B-25 - B-26.)

The CAFC concurred, stating: "Environmental has not shown error in the finding that the Trencor process is the same as, operates the same as, and achieves the same result as the claimed process. It thus constitutes not only literal but substantive infringement." (Pet. App. A-11 - A-12.)

## ARGUMENT.

### **The Decisions Below Are Not in Conflict With the Law Said in the Questions Presented to Have Been "Set Aside".**

Petitioners criticize the CAFC because it made no mention of the so-called "doctrine of equivalents in reverse." (Petition, p. 4.) But that doctrine becomes applicable only where a patented process is so far changed in principle from a patented process that it performs the same or a similar function *in a substantially different way*, but nevertheless falls within the literal words of a patent claim. *Graver Tank & Mfg. Co. v. Linde Air Products Co.* 339 U.S. 605, 608-609 (1950).

The instant case, however, contains extensive findings that petitioners' accused process and the patented process involved the same principles, use the same steps, perform those steps in the same sequential order and produce the same result. The CAFC found no error in these findings and concurred with the holding of the district court that there was literal and substantive infringement. In view of those findings of sameness between the processes, the "doctrine of equivalents in reverse", requiring as it does performance "in a substantially different way", has no applicability. The silence of the CAFC as to the doctrine simply spoke to the obviousness of its inapplicability to the facts before the court.

Thus the petition in actuality seeks a review by this Court to determine whether the CAFC correctly applied the "clearly erroneous" standard to the infringement findings made by the district court. Petitioners point only to an argument made by applicant's attorney in the early stages of prosecution of the '877 patent and assert that it should be treated as conclusively establishing that petitioners' process performs in



a substantially different way. Having failed in their assertion that applicant's argument created a file wrapper estoppel, petitioners attempt to produce the same effect in the guise of so-called claim interpretation. In doing so, they ignore the other portions of the file wrapper of the '877 patent refuting that interpretation and the substantial technical evidence which supports the findings of substantive sameness between the patented process and petitioners' process.

Petitioners' second question is similarly bottomed upon a factual assertion that is directly contrary to express findings made by the district court and affirmed by the CAFC. Petitioners' assertion is that the patentee placed a limitation, i.e., "prior to contact", upon certain words in claims of the '877 patent. The district court however made findings which supported its conclusion that none of the independent claims of the '877 patent were expressly modified or modified by implication to include the "prior to contact" phrase. (Conclusions 16, 17, Pet. App. B-32.)

The district court noted that the expression of the same limitation in dependent claim 11 of the '877 patent "supports the conclusion that the independent claim (i.e., claim 1) has a broader scope." (Conclusion 13, Pet. App. B-31.) On this point, the CAFC, after stating its other reasons for rejecting the estoppel argument of petitioners, stated: "Moreover, as Judge Pfaelzer recognized, the phrase omitted from claim 1 is specifically included in claim 11, indicating that claim 1 was allowed without the phrase *for reasons other than the cited remarks made to the examiner.*" (Pet. App. A-12 - A-13, emphasis supplied.)

In no sense was the CAFC holding contrary to the holding in *Kemart Corp. v. Printing Arts Research Laboratories, Inc.* 201 F.2d 624, 633 (9th Cir. 1953) quoted in the petition. In the latter case, the patentee's broadest claim would have, without the limitation appearing in other claims, been

broader than his actual invention. No such factual situation is present in the instant case. The claims of the '877 patent are commensurate with the scope of the invention delineated by the court's findings. To add the limitation urged by petitioners would improperly limit the claims of the '877 patent to the preferred embodiment of the invention described in the specification of the patent, a narrowing of the scope of a meritorious invention expressly rejected by the district court and by the CAFC. (Pet. App. A-12.)

**Conclusion.**

The petition for a writ of certiorari should be denied.

Dated: November 23, 1983.

Respectfully submitted,

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